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April 9, 1997

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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Historical Research Center, Inc.

Serial No. 74/166,013

Kevin P. Crosby and Mark D. Bowen of Malin, Haley, DiMaggio &
Crosby, P.A. for applicant.

Kimberly Krehely, Senior Examining Attorney, Law Office 107
(Thomas Lamone, Managing Attorney).

Before Simms, Seeherman and Hohein, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

An application has been filed by The Historical
Research Center, Inc. to register the mark "THE HISTORICAL
RESEARCH CENTER" and design, as reproduced below, for "family
name etymology research services".¹

¹ Ser. No. 74/166,013, filed on May 13, 1991, based upon an
allegation of a bona fide intention to use the mark in commerce.
Subsequently, applicant disclaimed the words "RESEARCH CENTER" and

The Historical Research Center

Registration has been finally refused under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), on the basis of applicant's refusal to comply with a requirement for a disclaimer of the words "HISTORICAL RESEARCH CENTER," which the Examining Attorney claims are either generic or, alternatively, are at least merely descriptive of applicant's services, within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), since applicant's claim of acquired distinctiveness, pursuant to Section 2(f) of the statute, 15 U.S.C. §1052(f), is insufficient. Applicant, on the other hand, contends that the words "HISTORICAL RESEARCH CENTER" are neither generic nor are they otherwise merely descriptive of its services. However, with respect to the latter, applicant alternatively maintains that such words have been shown to have acquired distinctiveness and, therefore, a disclaimer thereof is not necessary.

Applicant has appealed. Briefs have been filed² and, at applicant's request, an oral hearing was held on April 9,

filed an amendment to allege use which sets forth dates of first use of September 12, 1992.

² Applicant, other than making the conclusory statement that, "[s]ince the Applicant has made a claim under Section 2(f) of the Lanham Act as to the phrase 'HISTORICAL RESEARCH CENTER,' the disclaimer requirement is obviated," has argued only the merits of

1997.³ We affirm the disclaimer requirement for the reason that, although not adequately proven to be generic, the words

the genericness issue in its initial brief. The Examining Attorney, however, has not only addressed the genericness issue, but also asserts, for the reasons stated in her brief, that "applicant has submitted an unacceptable claim of acquired distinctiveness as to the term 'HISTORICAL RESEARCH CENTER' based on an affidavit alleging substantially exclusive and continuous use of the term since September, 1988." Applicant, in its reply brief, nevertheless has focused primarily on the merits of the genericness issue, stating with respect to the other issues in this appeal only that, "if the Board reverses the Examiner's refusal based on genericness, the Applicant respectfully requests an opportunity to supplement their [sic] claim of distinctiveness if required." However, as noted in *In re Big Daddy's Lounges Inc.*, 200 USPQ 371, 372 (TTAB 1978), such piecemeal prosecution is not favored and, in any event, the file history (as discussed later in this opinion) reveals that applicant had a full and fair opportunity to present proper evidentiary support for its claim of acquired distinctiveness, but elected to rely solely upon a declaration, dated November 1, 1994, of substantially exclusive and continuous use of the words "HISTORICAL RESEARCH SOCIETY" for a period in excess of six years. Applicant's request in its reply brief to supplement its distinctiveness claim is accordingly denied.

³ Applicant, at the oral hearing, asserted that the only issue properly before us on appeal is whether the words "HISTORICAL RESEARCH CENTER" are generic for its services. Applicant, in view thereof and noting once again its desire to supplement its acquired distinctiveness claim, requested that the application be remanded to the Examining Attorney for further consideration of the issue of mere descriptiveness and the alternative issue of the sufficiency of a showing of acquired distinctiveness. We agree with the Examining Attorney, however, that in addition to the issue of genericness, the issue of mere descriptiveness and the alternative issue of the sufficiency of applicant's Section 2(f) showing are properly before the Board in this appeal as the following review of the file history of this case makes clear.

The initial Office action required applicant to enter a disclaimer of the words "THE HISTORICAL RESEARCH CENTER" since "the wording is at least merely descriptive when viewed in connection with applicant's services." Applicant, in response, argued that such words were suggestive rather than descriptive, but also provided information as to the extent of its use of its mark, including the number of its licensees and the amount of its sales. In reply, the Examining Attorney withdrew the requirement for a disclaimer of all wording in the mark and, instead, required that applicant "insert a disclaimer of RESEARCH CENTER" because such words are "at least merely descriptive when viewed in connection with research services." The Examining Attorney, however, then "reevaluated the application

and determined" that, in light of a search of the "NEXIS" database, it "is necessary to reinstate the requirement for a disclaimer of the entire phrase 'HISTORICAL RESEARCH CENTER,' as it is at least merely descriptive when used in connection with the applicant's services." Applicant replied, contending that, due to its "extensive, continuous, and substantially exclusive use of the indicator 'Historical Research Center' since September, 1988 ... , that expression has become distinctive of Applicant's ... services and, hence, the primary meaning thereof has taken on servicemark [sic] significance." Specifically, referring to "[t]he forthcoming Declaration" of its president, applicant's counsel asserted inter alia that, while not used as part of applicant's composite mark until September 12, 1992, "the expression against which the disclaimer requirement is directed has been used continuously and substantially since September, 1988"; that such expression has become distinctive of applicant's services; that its revenue under the expression "total[s] approximately \$15 million, which translates into approximately \$45 million in retail sales"; and that applicant "has expended substantial sums" on "advertisements featuring the expression 'Historical Research Center'" which, like the representative copy of an ad which appeared in the May 1992 issue of Entrepreneur magazine, have run "in various widely circulated media". Again, the Examining Attorney maintained the requirement for a "disclaimer of HISTORICAL RESEARCH CENTER ... because of its at least merely descriptive nature when viewed in connection with applicant's services." Moreover, upon further review of the application, the Examining Attorney--for the first time--explicitly stated as a basis for the disclaimer requirement that "[t]he wording HISTORICAL RESEARCH CENTER is generic when viewed in connection with applicant's services." The Examining Attorney added, however, that:

Alternatively, the requirement for a disclaimer of HISTORICAL RESEARCH CENTER due to its merely descriptive nature when viewed in connection with applicant's services is maintained. The examining attorney has reviewed applicant's claim of acquired distinctiveness under Trademark Act Section 2(f), and notes that the information regarding the length of time the portion of the mark for which registration is sought under Section 2(f) has been used, advertising expenditures and sales figures has not been accompanied by a declaration under 37 C.F.R. Section 2.20. Additionally, applicant's "samples" of advertisements, consisting of a single advertisement which applicant states was placed in May of 1992, is insufficient to establish extensive promotion of HISTORICAL RESEARCH CENTER as a source indicator of applicant's services.

Applicant, in response, disclaimed the word "RESEARCH," but otherwise argued against the Examining Attorney's contentions, including the alternative positions regarding mere descriptiveness and the insufficiency of the showing of acquired distinctiveness. The Examining Attorney then made the disclaimer requirement final, asserting that "[o]n the record established in this case, it is clear

"HISTORICAL RESEARCH CENTER" nevertheless are otherwise merely descriptive of applicant's services and have not been sufficiently shown to have acquired distinctiveness.

According to the Examining Attorney's brief, "[t]he term 'HISTORICAL RESEARCH CENTER,' when used in connection with providing family name etymology research services, is generic because it would be perceived by potential users of the applicant's services as being a nonproprietary name of a genus or category in which the services fall, i.e., historical research center services." While conceding that such term "is not the common or apt name for the applicant's identified services," the Examining Attorney insists that the terminology in issue "is a 'generic adjective'" inasmuch as it "is so highly descriptive of

that [the literal portion of] applicant's proposed mark is, at a minimum, merely descriptive." Applicant replied, amending its disclaimer to set forth the words "RESEARCH CENTER" and submitting a declaration from its president. The declaration states only that "the expression 'The Historical Research Society' has been in use as a servicemark [sic] ... by applicant continuously from September, 1988 to the present" (i.e., November 1, 1994) and that, "[a]s such, the expression has become distinctive as applied to Applicant's services by reason of substantially exclusive and continuous use thereof as a servicemark [sic] by Applicant in commerce for over five years." The Examining Attorney, however, continued the final refusal, stating that "[t]he claim of distinctiveness ... and the disclaimer of 'RESEARCH CENTER' are not accepted" and that, instead, "the words 'HISTORICAL RESEARCH CENTER,' when viewed in relation to the claimed services, are generic"

It is therefore plain that the issues of mere descriptiveness and the sufficiency of applicant's acquired distinctiveness claim are also involved in this appeal. Applicant had the opportunity to present whatever evidence it wished in connection with its alternative claim of acquired distinctiveness, but chose to submit a declaration based solely upon substantially exclusive and continuous use of the words "HISTORICAL RESEARCH CENTER" in connection with its services for a period, as of November 1, 1994, in excess of six years. The request for a remand is accordingly denied as unwarranted.

the central characteristic of the claimed services, i.e., the applicant's record keeping and research facilities, that it identifies a genus in which the services fall, [namely,] historical research services."

Furthermore, while correctly noting that no amount of evidence of acquired distinctiveness would entitle applicant to registration of a generic term, the Examining Attorney asserts, with respect to applicant's claim of acquired distinctiveness for the words "HISTORICAL RESEARCH CENTER" on the basis of a declaration of substantially exclusive and continuous use thereof since September 1988, that:

Even if the ... Board found that "HISTORICAL RESEARCH CENTER" is not generic for a service such as the applicant's, the words are so highly descriptive that the evidence of record would be insufficient to establish acquired distinctiveness. At a minimum, some evidence regarding the nature and extent of advertising and the level of public recognition of the term "HISTORICAL RESEARCH CENTER" as a mark would be necessary to establish the claim of distinctiveness.

In support of her contentions, the Examining Attorney relies upon excerpts from computerized searches of certain electronic databases,⁴ the most pertinent of which are reproduced below (**emphasis added**):

[T]he Los Angeles Philharmonic is developing a new facility to preserve philharmonic memorabilia and serve as a

⁴ Specifically, searches of the "ALLNWS" file of the "NEWS" library and the "CURRNT" file of the "NEXIS" library using, in each case, the search request "HISTORICAL RESEARCH SOCIETY" were respectively conducted on April 12, 1994 and October 21, 1992.

historical research center. -- L.A. Times, July 17, 1993, Calendar, at 2, col. 1;

"Those are among the Valentine's Day announcements from the **Historical Research Center**, which provides **historical research and data on anyone's family name.**" -- Seattle Times, February 12, 1993, at E1;

AIR FORCE Magazine relies on Air Force Aerial Victory Credits, published by the Air Force **Historical Research Center**. This source does not list gunners as aces because of the difficulty in apportioning individual credit when so many gunners were involved -- Air Force Magazine, August 1992, at 5;

In addition to being a repository for Air Force **historical** documents, the **Historical Research Center**, performs **research and other historical services** for the Air Force. The **center's** staff answers requests for **historical** information -- Id., May 1991, at 123;

The combined effort, to be called the St. Louis **Historical Research Center**, will operate in the society's library, in the former United Hebrew Temple on Skinker Boulevard. -- St. Louis Post-Dispatch, March 13, 1991, News, at 3A (article headlined: "HISTORICAL SOCIETY, UMSL TO PLOT AREA'S PAST");

In the past the building has been an important **historical research center** and now it is becoming a wonderful resource for the community -- Newsday, January 25, 1990, News, at 22;

The **history** of the Pacific Southwest, including California, Arizona, parts of Nevada and Baja California, is the focus of a **historical research center** with more than 15,000 books and pamphlets. It is open to the public, although materials are not available for circulation. -- L.A. Times,

April 1, 1989, Orange County Life, at 2, col. 1;

Remembering the Holocaust is not enough. Holocaust museums, activist groups, **historical research centers**, films and paintings can, of course, deepen our sensitivity to injustice. -- Id., March 16, 1986, Book Review, at 10;

The largest collection of material pertaining to Ukrainian immigration is stored at the Immigration **Historical Research Center** at the University of Minnesota in St. Paul. -- N.Y. Times, August 25, 1985, Section 11NJ, at 19, col. 1; and

Jernay, who has a Ph.D. in history from the University of Wisconsin, heads an **historical research center** funded by the government that, in his own words, is "decolonizing Libya's **history**." -- Washington Post, August 4, 1979, at A16.

The Examining Attorney also relies upon the following definitions, which are of record, from The American Heritage Dictionary (2d college ed. 1982) to bolster her viewpoint:

"**historical**," which is defined at 614 as meaning "1. Of, relating to, or of the character of history. 2. Based on or concerned with events in history. 3. Having considerable importance or influence in history; historic; 4. Diachronic. -- See usage note at **historic**.";⁵

"**history**," which is listed at 614 as signifying, inter alia, "1. A narrative of

⁵ Such note, we observe, indicates in particular that (*italics in original*):

Usage: *Historical* refers to whatever existed in the past, whether regarded as important or not Events are *historical* if they happened, *historic* only if they are regarded as important. *Historical* refers also to anything concerned with history or the study of the past: a *historical novel*; *historical discoveries*

events; story. 2. A chronological record of events, as of the life or development of a people or institution, often including an explanation of or commentary on those events. 3. The branch of knowledge which records and analyzes past events. 4. The events forming the subject matter of history.";

"**research**," which is set forth at 1051 as connoting "1. Scholarly or scientific investigation or inquiry. 2. Close and careful study.";

"**center**," which is defined at 252 as meaning, in relevant part, "5. a. A place of concentrated activity or influence: a *financial center*. 6. A person or thing that is the chief object of attention, interest, activity, or emotion."; and

"**etymology**," which is listed at 468 as denoting "1. The origin and historical development of a linguistic form as shown by determining its basic elements, earliest known use, and changes in form and meaning, tracing its transmission from one language to another, and identifying its cognates in other languages. 2. The branch of linguistics that deals with etymologies."

In addition, the Examining Attorney points to the following language, which appears in the advertising literature submitted by applicant, as backing her position (*italics in original; emphasis added*):

H.R.C.'s in-house research department has assembled data covering over 300,000 **family name histories** from all over the world. Our research department consists of 15 full-time researchers, each with multilingual skills. Our library is one of the largest and most extensive of its kind in the world.

Such literature, we notice, also contains the following pertinent information (*italics in original; emphasis added*):

*We've got your name...and probably the name of everyone you know in our exclusive **family name history** database!*

....

Our H.R.C. Dealers offer a wide variety of upscale **Family Name History** and Heraldic Products at extremely affordable prices!! Each dealer can provide a series of high quality products that complement each other.

....

....

We have developed a fully computerized, easy to use program to instantly access and print a beautiful parchment finished **Family Name History** certificate using a state of the art ... letter quality printer.

Applicant maintains, however, that the Examining Attorney has failed to meet her burden of showing that, to the relevant public for its family name etymology research services, the primary significance of the words "HISTORICAL RESEARCH CENTER" is that of a generic term for such services. In particular, while not disputing that its services "necessarily involve research regarding factual occurrences," applicant insists with respect to the dictionary definitions presented by the Examining Attorney that (underlining and emphasis in original):

[N]owhere in the definition of "HISTORY" are family name etymologies mentioned. Rather, the definition of "HISTORY" refers to "events," and [an] "explanation of their causes" and how these "events" affect a nation or institution, and not to research involving family name etymology or any other etymology. It is respectfully submitted,

therefore, that the ordinary consumer would not understand the term "HISTORICAL" to primarily refer to something etymological and

the Examiner has not provided any evidence to the contrary.

The same might not be true if, for example, Applicant's services were recited as general and historical research (i.e., research of historical events) or if the objected to portion of Applicant's mark was instead "Family Name Etymology Research Center" or "Family Name History Research Center." In these hypothetical examples, the expression would be at least descriptive of Applicant's services. In the instant application, however, the Examining Attorney's reliance on the phrase "HISTORICAL RESEARCH CENTER" as being generic is inappropriate. The Applicant does not disagree that the term "the Historical Research Center" may have *some* significance to the public as being related to some type of research services. However, Applicant does not agree that the mark *principally* signifies the Applicant's services, as it must to be properly characterized as generic.
....

.... Additionally, Applicant's services do not include providing a center for conducting historical research. In fact, ... Applicant maintains hundreds of franchisees and dealers/distributors, so there is no single location or "CENTER" from which the family name etymologies are sold. Customers order a particular surname history, which is either created on the spot or ordered from Applicant, who either has the etymology already on hand from a previous customer or an etymology is custom made and shipped.

Therefore, the purchasing public does not primarily use or understand the term "HISTORICAL RESEARCH CENTER" to refer to "etymology research services." In other words, [such portion of] the mark is certainly not generic for the recited

services, and no evidence to the contrary has been produced by the Examiner.

As to the excerpts retrieved by the Examining Attorney from certain electronic databases, applicant contends that such evidence is "so indeterminate as to be insufficient proof of generic usage." Specifically, although applicant "does not disagree that the term 'Historical Research Center' may be used descriptively in some of the references cited by the Examiner," applicant asserts that such term "is at best suggestive" of its family name etymology research services since none of the excerpts use the term generically to refer to any type of etymological services.

In summary, applicant urges that the words "HISTORICAL RESEARCH CENTER" are not generic for its particular services because such services solely "relate to the origin and development of family names" and hence do not involve the conducting of historical research. As expressed in its reply brief, applicant maintains that the evidence offered by the Examining Attorney simply does not pertain to the type of services offered under its mark inasmuch as (**emphasis in original**):

[I]n each of the citations shown, the term "Historical Research Center" refers to places such as libraries and museums where **historical records** are kept and, thus, where historical research can be conducted. This media usage is consistent with the dictionary definitions provided by the Examiner. Specifically, according to the definitions cited, the term "Historical Research Center" denotes a center where research of events and explanations of their causes and how those events affect a nation or institution is

conducted. On the contrary, the wording which is the subject of the disclaimer requirement is not generic when applied to the Applicant's services, family name etymology research services.

It is well settled that in the case of a generic designation, the burden is on the Patent and Trademark Office to show the genericness of the designation by "clear evidence" thereof. See, e.g., In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). See also In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987). As to the standard for evaluating genericness, the Board in In re Leatherman Tool Group Inc., 32 USPQ2d 1443, 1449 (TTAB 1994), stated that:

The test for determining whether a designation is generic, as applied to the goods [or services] set forth in an application or registration, turns upon how the term is perceived by the relevant public. See Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551, 1552-53 (Fed. Cir. 1991) and cases cited therein at 1553. Such perception is the primary consideration in a determination of genericness. See Loglan Institute Inc. v. Logical Language Group Inc., 962 F.2d 1038, 22 USPQ2d 1531, 1532 (Fed. Cir. 1992). As Section 14(3) of the Trademark Act, 15 U.S.C. §1064(3), makes clear, "[a] ... mark shall not be deemed to be the generic name of goods [or services] solely because such mark is also used as a name to identify a unique product [or service]"; instead, "[t]he primary significance of the ... mark to the relevant public rather than purchaser motivation shall be the test for determining whether the ... mark [is or] has become the generic name of the goods [or service] on or in connection with which it has been used." Consequently, if the designation sought to be registered is understood by the relevant public primarily

to refer to the class or genus of goods [or services] at issue, the term is generic. See H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., [728 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)] Evidence of the relevant public's understanding of a term may be obtained from any competent source, including newspapers, magazines, dictionaries, catalogs and other publications. See In re Northland Aluminum Products, Inc., 777 F.2d 1566, 227 USPQ 961, 963 (Fed. Cir. 1985).

Upon careful consideration of the entire record, we agree with applicant that the words "HISTORICAL RESEARCH CENTER" have not been shown by clear evidence to be generic for family name etymology research services. Contrary to the Examining Attorney's argument, the evidence of record does not demonstrate that the words are understood by those interested in the origin and development of family names as designating or signifying a category, class or genus of research center services pertaining thereto. The Examining Attorney, as applicant has observed, admits that the words "HISTORICAL RESEARCH CENTER" are not the common or apt descriptive name for applicant's family name etymology research services. Such is confirmed by the evidence of record, which at best establishes, as applicant concedes, that the words "HISTORICAL RESEARCH CENTER" generally connote a place or center devoted to historical research, but such words do not specifically name a category, class or genus of etymological research. While, to be sure, family name etymology research services involve a type of historical research in the sense of delving into the origin and development of particular surnames, such is not the same as saying that the general public, which

principally constitutes the relevant purchasing public for applicant's services, regards the words "HISTORICAL RESEARCH CENTER" as primarily signifying a center for historical research services directed to family name etymologies.⁶

In this regard, we note that while, as shown by the dictionary definitions of record, the words "research" and "center," both separately and combined into the term "RESEARCH CENTER," are clearly generic as applied to research center services, including those offered by applicant, which are rendered or provided at a centralized location or place, the dictionary definitions indicate that applicant's family name etymology research services are "historical" only in the sense that "etymology" necessarily involves the analysis of the events relating to the origin and development of various family names. Nothing in the dictionary definitions demonstrates, however, that the relevant purchasing public for applicant's services regards the words "HISTORICAL RESEARCH CENTER" as designating a specific class, category or genus of family name etymology services. Nor do the references in the specimens of record to the phrases "family name histories" and "family name history" establish that, with respect to applicant's services, the relevant purchasing public views the word "historical" as being synonymous, or

⁶ Stated otherwise, while family name etymology research services are encompassed within the broad rubric of historical research center services since they involve research of historical facts, it is plain from the evidence of record that not all historical research center services constitute or would be regarded as family name etymology research services.

essentially so, in meaning with or otherwise primarily signifying either the terms "etymology" or "etymological".

Furthermore, although the excerpts from certain electronic databases show use of the words "HISTORICAL RESEARCH CENTER" to refer to places such as libraries, museums and the like where archival records are kept for purposes of facilitating historical research with respect to various events, including their causes and subsequent effects, only the article excerpted from the February 12, 1993 issue of the Seattle Times uses such words in the context of family name etymology services. The manner of such use, however, is not in reference to a specific category, class or genus of services. Instead, it refers to a particular entity or organization, identified as the "Historical Research Center," which is said to provide "historical research and data on anyone's family name."⁷ This single listing, with its mixed and consequently indeterminate usages of the terminology "historical research," is simply insufficient to convince us that, when given their ordinary dictionary meanings, the relevant purchasing public for applicant's services understands the combination of the words "HISTORICAL RESEARCH

⁷ Applicant, in its sole reference to such excerpt, merely states in its initial brief that the article in "the February 12, 1993 Final Edition of *The Seattle Times* ... shows the term 'THE HISTORICAL RESEARCH CENTER' used as a trademark (or service mark/trade name) and not as a descriptive term of the services performed by the party referred to in the article." Applicant fails to indicate, however, whether it (or one of its franchisees) is the party referred to therein. Nevertheless, we have assumed for purposes of this appeal that, in light of applicant's trade name, the reference in the article to "the Historical Research Center" is a reference to applicant (or one of its franchisees) and does not pertain to an unrelated third party.

CENTER" as primarily signifying any research center or place devoted to family name etymology research services. See, e.g., In re Merrill Lynch, Pierce, Fenner & Smith, Inc., supra at 1144.

In summary, the evidence collectively relied upon by the Examining Attorney does not plainly reveal that, to the general public, the words "HISTORICAL RESEARCH CENTER" primarily signify a name for applicant's particular services, which is the function of a generic term therefor. Accordingly, on the record before us, we conclude that such words have not been shown by clear evidence to be generic for family name etymology research services.⁸

However, as to the issue of whether the words "HISTORICAL RESEARCH CENTER" are otherwise merely descriptive of applicant's services, we concur with the Examining Attorney that such is indeed the case. It is well settled, in this regard, that a term or phrase is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See In re Abcor Development Corp.,

⁸ This case is thus unlike, for example, the situation presented in In re Analog Devices Inc., 6 USPQ2d 1808, 1810 (TTAB 1988), *aff'd in op. not for pub.*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989), in which a variety of technical dictionaries and publication excerpts clearly demonstrated that the term "ANALOG DEVICES" named generically each of the specific electronic data communications devices listed in the application for which registration of such term as a trademark was sought. Similarly, the same is true in each instance for the goods and services encompassed by the generic terms mentioned in the dissenting viewpoint of Administrative Trademark Judge Simms.

588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term or phrase describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or aspect them. Moreover, whether a term or phrase is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term or phrase would have to the average purchaser of the goods or services because of the manner of its use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

It is our view that, when applied to applicant's family name etymology research services, the phrase "HISTORICAL RESEARCH CENTER" immediately describes, without conjecture or speculation, a significant characteristic or feature of applicant's services, namely, that applicant or its franchisees provide a center or place from which persons may obtain research services concerning the history or etymology of their family names. Both the dictionary definitions of record, as well as those of which we take judicial notice,⁹ make clear that the history of a family

⁹ For instance, The Random House Dictionary of the English Language (2d ed. 1987) defines "etymology" at 667 as meaning "1. the derivation of a word. 2. an account of the history of a particular word or element of a word. 3. the study of historical linguistic change, esp. as manifested in individual words." The same dictionary lists "historical" at 907 as connoting, inter alia, "1. of, pertaining to, treating, or characteristic of history or past events: *historical records; historical research* 2. based on or

name, i.e., the story of its origin and development, is a kind of etymology or historical account. "Etymology," by definition, is a type of history, and hence is "historical," in the sense that it is concerned with the derivation, i.e., the historical origin and development, of words, including those which constitute family names, i.e., surnames. Providing a center for historical research of family names, at which access may be obtained, by or for members of the public, to either applicant's computerized database of information on the derivation of surnames or the research department it maintains for such purpose, is a significant aspect of applicant's services.¹⁰ Plainly, nothing in the combination of the words forming the phrase "HISTORICAL RESEARCH CENTER" is incongruous, indefinite or susceptible to multiple connotations, nor is any imagination, cogitation or gathering of further information necessary in order for actual and potential customers of applicant's family name etymology research services to perceive exactly the merely descriptive significance of such phrase as it relates to a significant

reconstructed from an event, custom, style, etc., in the past: *an historical reenactment of the battle of Gettysburg....*" It is well settled that judicial notice may properly be taken by the Board of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

¹⁰ The fact that applicant and its franchisees render family name etymology research services from more than one location is of no significance inasmuch as each location is plainly a center from which such services are offered to the public.

characteristic or feature of those services, namely, a family name history research center.

In addition, it is readily apparent from the specimens of use furnished by applicant, as well as the database excerpt of record from the February 12, 1993 edition of the Seattle Times, that the words "HISTORICAL RESEARCH CENTER" forthwith convey, in the context of family name etymology research services, that the center or place operated by applicant (or one of its franchisees) provides family name histories, i.e., historical research as to the derivations of family names. The fact that none of the other excerpts show third-party usage of the words "historical research center" in connection with services of the same or similar types as those offered by applicant is not fatal to the Examining Attorney's position since, even if applicant is the only entity which is actually using such words, that fact alone cannot alter the merely descriptive significance of the words and bestow service mark rights therein. See, e.g., In re Mark A. Gould, M.D., 173 USPQ 243, 245 (TTAB 1972) and cases cited therein. The virtual absence of any third-party usages is thus not dispositive where, as here, the words "HISTORICAL RESEARCH CENTER" project unequivocally a merely descriptive connotation. See In re MBAssociates, 180 USPQ 338, 339 (TTAB 1973).

Consequently, because the words "HISTORICAL RESEARCH CENTER," although not generic, nevertheless immediately convey information about a significant characteristic or feature of applicant's family name etymology research services, namely, that applicant provides a center or place from which research services

concerning the history or etymology of customers' family names may be obtained, the words are merely descriptive of applicant's services--and must be disclaimed--absent a showing that they have acquired distinctiveness.

Turning, therefore, to the alternative issue of the sufficiency of applicant's claim of acquired distinctiveness, we agree with the Examining Attorney that the evidence submitted by applicant in support thereof is insufficient to show that the words "HISTORICAL RESEARCH CENTER" have become distinctive of its services. As pointed out in *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988), the greater the degree of descriptiveness which a term or phrase possesses, the heavier is the applicant's burden of proving that it has become distinctive of its goods or services. The words "HISTORICAL RESEARCH CENTER," although not generic, are nevertheless highly descriptive, for the reasons previously explained, of applicant's family name etymology research services and, accordingly, require a substantial evidentiary showing to establish a prima facie case of acquired distinctiveness.

Applicant, as noted earlier, has elected to submit as the basis for its claim of acquired distinctiveness a declaration from its president which sets forth, as the sole support therefor, an allegation of substantially exclusive and continuous use in commerce of the words "HISTORICAL RESEARCH CENTER" for its services for a period, commencing in September 1988, in excess of six years. Given the high degree of descriptiveness of such

words, as applied to applicant's family name etymology services, we find that applicant's mere use thereof, especially without any representative samples of any advertising or other promotional materials demonstrating the manner of use thereof over the period of time asserted by applicant, is insufficient to establish acquired distinctiveness. See, e.g., In re Kalmbach Publishing Co., 14 USPQ2d 1490, 1492 (TTAB 1989) [evidence consisting solely of a verified statement of use during a 12-year period held insufficient to establish that highly descriptive designation "RADIO CONTROL BUYERS GUIDE" had become distinctive of magazines] and In re Gray Inc., 3 USPQ2d 1558, 1559 (TTAB 1987) [because it is highly descriptive of "burglar and fire alarms" and "burglar and fire alarm surveillance services," in order "to support registration of PROTECTIVE EQUIPMENT on the Principal Register a showing considerably stronger than a prima facie statement of five years' substantially exclusive use is required"].¹¹

Decision: The requirement for a disclaimer under Section 6(a) of the words "HISTORICAL RESEARCH CENTER" is affirmed. Nevertheless, in accordance with Trademark Rule 2.142(g), this decision will be set aside and applicant's mark will be published for opposition if applicant, no later than thirty days from the mailing date hereof, amends its present

¹¹ We hasten to add that even if applicant had responded to the Examining Attorney's requirement for a declaration which included the sales figures, advertising expenditures and extent of licensing alleged by its counsel in its responses to certain Office actions, the high degree of descriptiveness inherent in the words "HISTORICAL RESEARCH CENTER," as used in connection with applicant's services, would still preclude a sufficient showing that such words have in fact become distinctive.

disclaimer of the designation "RESEARCH CENTER" to one which appropriately disclaims the words "HISTORICAL RESEARCH CENTER".¹²

E. J. Seeherman

G. D. Hohein
Administrative Trademark Judges,
Trademark Trial and Appeal Board
Simms, Administrative Trademark Judge, concurring in part and dissenting in part:

I concur in that part of the opinion which holds that applicant has failed to show that the words "HISTORICAL RESEARCH CENTER" have become distinctive of applicant's services. The majority states that, in view of the high degree of descriptiveness inherent in these words, the scant evidence offered by applicant is insufficient to permit registration without a disclaimer. Where I disagree with the majority is in the conclusion that these words are not generic.

The Examining Attorney states that this applicant conducts research into the origin, derivation and historical development of family names, and applicant admits that "it's (sic) services necessarily involve research regarding historical facts." Response, filed Feb. 3, 1994, p. 3. A newspaper excerpt of record indicates that applicant "provides historical research and data on anyone's family name." (Seattle Times, Feb. 12,

¹² See In re Interco Inc., 29 USPQ2d 2037, 2039 (TTAB 1993). For the proper format for a disclaimer, attention is directed to TMEP

1993.) Indeed, the dictionary definition of "etymology" indicates that this study involves "the origin and historical development of a linguistic form..." Etymological research, therefore, is a form of historical research devoted to the history of certain types of words. In particular, as the majority concedes, applicant's services involve historical research into the origins of family names and the selling of family name histories.

Apparently accepting applicant's argument that the words HISTORICAL RESEARCH CENTER are not generic because they do not "primarily refer to something etymological" (main brief, p. 5), and even though asserted marks must be considered, not in the abstract, but in relation to applicant's services, the majority concludes that the words HISTORICAL RESEARCH CENTER are not generic--that is, they do not primarily signify applicant's family name research services--because these words do not designate a category or class of research services pertaining to applicant. Although the majority concedes that applicant's family name research services are encompassed within, or involve a type of, the broader "historical research center" services, the public would not, according to the majority, regard these words as primarily signifying a research center for family name research services. Nevertheless, the majority says that the clearly broader and less limiting words RESEARCH CENTER "are clearly generic as applied to research center services, including

those offered by applicant..." Opinion, p. 14. Thus, the majority presumably is saying that these two words alone primarily signify a category of applicant's services and that they are generic for specific services that fall within this broad category. In other words, if the words sought to be disclaimed here were only the broad terms RESEARCH CENTER, the majority would presumably have affirmed the requirement for a disclaimer by finding these words to be generic, not just merely descriptive. The majority's reasoning and this anomalous result are simply not understood.

According to the majority, a broader and more indefinite term (RESEARCH CENTER) is generic and unregistrable without a disclaimer¹³ but the more specific phrase HISTORICAL RESEARCH CENTER is not, even though the latter would seem to more narrowly circumscribe the specific nature of applicant's services. That is to say, despite the addition of the word "HISTORICAL," which undoubtedly seems to narrow the type or category of research center services applicable to applicant, the majority does not find these words generic. It seems to me that, to be consistent, the majority would not find that the words RESEARCH CENTER are generic because they, too, would not be considered as "designating or signifying a category, class or genus of research center services pertaining" to applicant.

¹³ "RESEARCH CENTER" could possibly refer to such diverse research centers as scientific, educational, computer, biomedical, aeronautical, archeological, legal, behavioral, agricultural, nutritional, astronomical, oceanographic, etc. research centers.

Opinion, p. 13. Under the majority's reasoning for not holding the entire phrase generic, one would assume that, not only would the majority find that the words RESEARCH CENTER are not generic, but also such broad and all-inclusive terms as, for example, "MOTOR VEHICLE" would not be generic for, say, such specific goods as motorcycles because these words would not be seen by the public as primarily signifying motorcycles, although motorcycles are "encompassed within the broad rubric" of "motor vehicles." Of course, the public policy behind refusing to register such broad terms (or to exclude the possibility of secondary meaning) is to preserve competitors' rights to freely describe and name their goods and services for what they are. J. T. McCarthy, McCarthy On Trademarks and Unfair Competition, Volume 2, Sec. 12:2 (4th ed. 1996).

Nevertheless, having found the words HISTORICAL RESEARCH CENTER not to be generic, the majority apparently has little trouble in concluding that these words "immediately describe" applicant's services, noting that these words are not "incongruous, indefinite or susceptible to multiple connotations, nor is any imagination, cogitation or gathering of further information necessary in order for actual and potential customers of applicant's family name etymology research services to perceive exactly the merely descriptive significance of such phrase..." Opinion, p. 18.

The fact is, however, as the majority unwittingly seems to recognize when it calls the broad words RESEARCH CENTER generic, even broad terms which name categories or classes of goods or services are generic. In other words, contrary to the majority's holding with respect to the words HISTORICAL RESEARCH CENTER, a term does not have to specifically name a narrow category so long as the goods or services are encompassed within the broad term. Case law seems clear on this point. For example, in *In re Analog Devices*, 6 USPQ2d 1808 (TTAB 1988), *aff'd. unpublished*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989), the Board held that the term ANALOG DEVICES named a category or class of devices having analog capabilities and was generic for a number of products such as operational amplifiers, power supplies, converters, transducers, switches, etc., some of which were in the nature of analog devices. In the face of applicant's argument that the term is a nebulous and vague one, the Board responded, at 1810:

However, while we readily concede that the category of products which the term "analog devices" names encompasses a wide range of products in a variety of fields, we do not believe this fact enables such a term to be exclusively appropriated by an entity for products, some of which fall within that category of goods. For example, while terms such as "digital devices," "computer hardware," "computer software" and "electronic devices," just to name a few, may be broad and even nebulous terms, nevertheless, these terms may not be exclusively appropriated but must be left for all to use in their ordinary generic sense.

The majority's attempt to distinguish this case is unavailing.

Similarly, in *In re Medical Disposables Co.*, 25 USPQ2d 1801 (TTAB 1992), the Board, when confronted with the argument that the term MEDICAL DISPOSABLES was not generic and need not be disclaimed because of evidence of acquired distinctiveness, said, at 1805:

The fact that the excerpts submitted do not all specifically refer to the type of articles manufactured and sold by applicant does not lessen the effect of this evidence. Obviously there are a number of types of supplies used in medical practice which are disposable and may, for that reason, be identified by that phrase. Thus, the term, "medical disposables" covers the entire class of products intended for medical use and which have in common the fact that they are to be disposed of following a single use. Any or all of these products may be identified by the common term "medical disposables".

Here, too, the fact that the phrase "HISTORICAL RESEARCH CENTER" may include a variety of other services besides those offered by applicant does not mean that this broad phrase is not generic for applicant's family name history research services. See also *Remington Products In. v. North American Philips Corp.*, 892 F.2d 1576, 13 USPQ2d 1444 (Fed. Cir. 1990) (TRAVEL CARE describes a category of products a traveler takes along to care for something, and thus is incapable of distinguishing applicant's personal care products and accessories for travelers), *In re Helena Rubinstein, Inc.*, 410 F.2d 438, 161 USPQ 606 (CCPA 1969) (PASTEURIZED held unregistrable on the

Supplemental Register for face cream, where this term is obviously also generic for other goods, such as dairy products), In re Harcourt Brace Jovanovich, Inc., 222 USPQ 820 (TTAB 1984) (LAW & BUSINESS held generic for arranging and conducting seminars in the field of business law, where these words obviously could name various other services as well) and In re Space-General Corp., 136 USPQ 77 (TTAB 1962)(SPACE ELECTRONICS held generic for "the broad field of activity in connection with which applicant's operations are primarily concerned" and for a variety of electronic equipment used for space navigation and for engineering and consulting services.

Finally, following the majority's reasoning concerning the alleged lack of specificity of the category named in the asserted mark, the majority would apparently find generic such phrases as FAMILY NAME HISTORICAL RESEARCH CENTER and HISTORICAL FAMILY NAME RESEARCH CENTER. I believe that all such terms are generic and the fact that applicant here has chosen to truncate its mark to HISTORICAL RESEARCH CENTER should not change the result. Certainly, the elimination of words from a generic expression to form a more easily pronounced or remembered phrase should not make such resulting term less generic. See In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). There, the Court held that the term GASBADGE was descriptive of gas monitoring badges, but Judge Rich, in a concurring opinion noted, at 219:

So, what is the name of this article? Appellant's own descriptive literature of record in the PTO provides the answer. The name is "Gas Monitoring Badge." This may be regarded as the full name. However, the users of language have a universal habit of shortening full names---from haste or laziness or just economy of words...I regard it as *inevitable* that a gas monitoring badge will be called a gas badge as the name of the goods to the same extent as gas monitoring badge is the name...

(Emphasis in original.) This decision, along with others that could be cited, is simply a recognition of the fact that there is usually not one, single generic name for a product or service but there may be several or many, all of which are incapable of trademark significance. McCarthy, *id.*, Sec. 12:9.

R. L. Simms

Administrative Trademark Judge,
Trademark Trial and Appeal Board